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| 09/733,900  | 12/12/2000  | Carlos O. Pinzon     | 05725.0595-00       | 5474             |
| 22852   | 7590        | 04/10/2006           | EXAMINER            |                  |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      | VENKAT, JYOTHSNA A  |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1615                |                  |

DATE MAILED: 04/10/2006

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**APR 10 2006**

**GROUP 1600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/733,900  
Filing Date: December 12, 2000  
Appellant(s): PINZON ET AL.

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Michelle E. O'Brien  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 1/17/06 appealing from the Office action mailed 6/2/05.

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**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

09/733,899

**(3) Status of Claims**

This appeal involves claims 321-322, 325, 330, 334-335, 337-338, and 348-354.

Claims 355-368 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-320, 323-324, 326-329, 331-333, 336 and 339-347 have been canceled.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

Claims 321-322, 325, 330, 334-335, 337-338, and 348-354 are rejected under 35 U. S. C. 103 over U. S. Patent 5,783,657('657) in view of U. S. Patent 6,423,324 ('324) and U. S. Patent 5,830,483 ('483). See office action dated 7/16/03 for the explanation regarding the above patents.

**(10) Response to Argument**

Appellants argue that patent '657 relates to methods of preparing gelling agents that can be used in formulating transparent gels at col. 1, lines 5-8, col. 2, lines 17-21, and claim 1 and gels are disclosed as being useful in a variety of compositions, including, for example, automobile wax/polish, furniture polish, metal cleaners/polishes, household cleaners, paint strippers, insecticides, fuels, toilet bowl rings, crayons, etc., in addition to cosmetics. See, e.g., at col. 14, lines 37-53 and the only exemplified formulation embodying the invention is in the form of a candle and the patent does not contain any teaching or suggestion whatsoever to formulate a cosmetic composition specifically containing at least one oil-soluble cationic surfactant.

In response to the above argument, patent '657 teaches the claimed polyamide polymer as being useful in formulating personal care products, which require gel-like or self supporting consistency. See the abstract. Reference is not only valid for example, but for the entire disclosure. The patent at col.3, lines 30-34 teach various personal care products. This includes

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lipstick, make-up, eye-make-up, lip-balm, and sun-care products. All these products belong to cosmetic products. The patent at col.14, lines 29-34 teaches to one of skilled in the cosmetic art that the combination of the polyamide polymer along with colorants as well as other ingredients to form lipstick and the lipstick has the advantage of imparting little if any undesirable color to the lipstick or any cosmetic. The patent does not teach the cationic surfactant, however the rejection is based on obviousness rejection and not on anticipation where the patent teaches the claimed polymer and the cationic surfactant. **Patent '657 at col.17, line 27 suggests the addition of emulsifiers also known as surfactants that can be combined with the polymer claimed.** Thus the patent clearly suggests the combination of polymer and emulsifier.

Appellants argue that there is no teaching or suggestion in patent '657 that would have led the skilled artisan to add an oil-soluble cationic surfactant to the compositions therein to produce a cosmetic composition with "outstanding properties," as the Office alleges and therefore, it is illogical to asses that one of skill in the art would have been motivated to add an oil-soluble cationic surfactant to '657 with the expectation of reducing synerisis and one of skill in the art simply would not have been motivated to remedy a problem that the reference itself states does not exist in it's compositions.

1. In response to the above argument, patent '657 teaches the same polyamide polymers as gelling agents and at col.14, lines 38-43 teaches the application of this gellant in various cosmetic personal care products and the patent '324 suggest the combination of the polyamide resin and also cationic surfactant and therefore one of ordinary skill in the art would be certainly motivated to combine the ingredients. The patent '324 at the paragraph bridging cols. 8-9 teaches to one of ordinary skill in the art that the composition can include blend of surfactants and the

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patent at col.10 definitely teaches to one of ordinary skill in the art that in addition to non-ionic surfactants, cationic or anionic surfactants can be used. Patent '324 teaches to one of ordinary skill in the art the advantages of using polyamide resin and blend of surfactants, which has the advantage of inhibiting hardening and loss of rub off availability. This loss of rub off availability is very popular among the consumer since these products are called "transfer resistant products". The patent '324 clearly teaches to one of ordinary skill in the art the advantages for the consumer at col.2, lines 39-45.

2. Appellants point out that patent '324 fails to teach or suggest at least one cationic surfactant at all, but rather, states that the surfactant is optional (Col. 8, line. 66 to col. 9, line 2.) and the reference specifically states that non-ionic surfactants are preferred.

3. In response to the above argument, the patent '324 at paragraph bridging col.s 8-9 teaches to one of ordinary skill in the art that the compositions optionally and preferably include surfactant or blend of surfactants. Patent is not only valid for the preferred embodiment, but also to the entire disclosure. Patent '324 was relied for the teaching of combination of polyamide resin with surfactants, which can be non-ionic or cationic or anionic. Patent '324 at col.10, lines 46-53 states that in addition to non-ionic surfactant, cationic surfactant can also be used as the surfactant. The patent '324 therefore clearly suggests the combination of polyamide resin and cationic surfactant. Patent '324 at col.9, teaches that surfactant acts as a viscosity modifier or thickener, whcih improves the texture of the composition.

4. Appellants argue that the desire to obtain a composition with "outstanding properties," such as modifying viscosity and achieving a rich appearance as disclosed in '483 (See July 16, 2003, Office Action, pp. 4-5.) is due to the inventive oil-in-water emulsion which contains an

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ionic emulsifier (see col. 4, lines. 45-52) and not specifically to the presence of an oil-soluble cationic surfactant as the Office implies.

5. In response to the above argument, patent '483 teaches the combination of non-ionic and cationic surfactants (ionic emulsifier), which can be oil soluble. Patent '483 teaches the combination of oil phase and emulsifying system, which can be non-ionic, and ionic which can be cationic. See the abstract and see col.3, lines 40 et. Seq. and see col.4, lines 11-14, where the patent teaches the claimed species belonging to cationic surfactant. Patent '483 at col.4, lines 45-55 teaches the advantages of this emulsion, which includes oil phase and emulsifiers.

6. Appellants at page 18 of the Brief argue that, when a claimed invention combines two known elements, a patentability determination rests on "whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination" and this has not been done in the present case.

7. In response to the above argument, patent '657 clearly teaches the combination of structuring polymer and emulsifier and patent '324 teaches the combination of polyamide resin and cationic surfactant and patent '483 teaches the specific cationic surfactant in cosmetic applications.

8. Therefore one of ordinary skill in the art would certainly be motivated to combine the structuring polymer of '657 and substitute the oil soluble cationic surfactant of '483 for the cationic surfactant in the compositions of '324 with the reasonable expectation of success that the compositions exhibit outstanding properties. The compositions exhibit gel-like or transparent consistency because of the polymer and when this is combined with surfactant, the surfactant has the advantage of providing improved texture to the composition. All the art applied is in the

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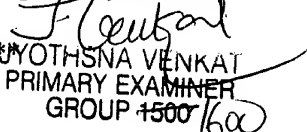
same field of endeavor where there is suggestion to one of ordinary skill the art the motivation to combine the ingredients, since all the ingredients have been used in the same cosmetic art. The expression " comprising " in the claims is inclusive of all the unrecited ingredients taught by the art. Therefore the subject matter as a whole is obvious within the meaning of 35 U. S. C. 103 over the combination of the patents '657, '324 and '483.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

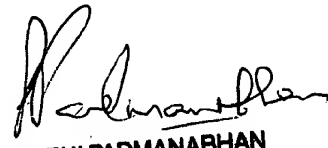
Respectfully submitted,

  
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